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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/803,636 | 03/18/2004 | John W. Sussmeier | F-802 | 5369 |

919 7590 10/23/2006

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EXAMINER

PRONE, JASON D

| ART UNIT | PAPER NUMBER |
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3724

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,636

Applicant(s)

SUSSMEIER ET AL.

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/1/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. In light of applicant's amendment and arguments in the response filed 15 August 2006, the examiner has withdrawn the election restriction.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-2 are rejected on the grounds of provisional nonstatutory obviousness-type double patenting as being unpatentable over claim 5 (5 is the combination of claims 1 and 4) of patent 7,021,184. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all elements of claims 1-2 of the instant invention 10/803,636 are found in claim 5 of patent 7,021,184. The differences between claims 1-2 of 10/803,636 and claim 5 of patent 7,021,184 lies

in the fact that the claims patent 7,021,184 include many more features and is thus much more specific (for example, one or more sensors). Thus claims 1-2 of 10/803,636 is in effect a "species" of the "generic" invention of claim 5 of patent 7,021,184. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1-2, of 10/803,636, are anticipated by claim 5, of patent 7,021,184, it is not patentably distinct from claim 5.

Claims 1 and 2, of the instant application, disclose limitations where the velocities are functions of the characteristics of the hardware and of the size of the work piece. Claims of patent 7,021,184 fail to disclose these "functions", however, Column 7 lines 14-16 discloses "the velocities are functions of the characteristics of the hardware and of the size of the work piece" and, therefore it would have been obvious to one of ordinary skill in the art that the velocities claimed were of the same functions in the instant application.

4. Claims 8-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10 and 12-14 of copending Application No. 11/286,036.

Although the conflicting claims are not identical, they are not patentably distinct from each other because 11/286,036 substantially claims the invention as claimed including the method of generating sheets, however, the claims are silent with respect to the velocities being functions of the characteristics of the hardware and of the size of the work piece. Page 4 paragraph [0049] (using 2006/0075860 as reference) of 11/286,036 discloses the velocities being functions of the characteristics of the

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hardware and of the size of the work piece. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have made the velocities as functions of the characteristics of the hardware and of the size of the work piece.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “right angle turn transport of the right angle turn mechanism”, of claim 1, and the “controller”, of claim 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: on page 9 line 10, item "100". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to because in Figure 2, item "22" does not have a reference line and therefore is not pointing at the item it represents. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary,

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the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

8. The disclosure is objected to because of the following informalities: Page 1 lines 4-6 should be replaced with "This application is a continuation-in-part of U.S. Patent 7,021,184 B2, titled System and Method for Providing Sheets to an Inserter System Using a Rotary Cutter, published April 04, 2006.".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. With regards to claim 1 lines 11-12, the phrase "the right angle turn mechanism transporting individual sheets with a right angle turn transport having a first velocity" is

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not clear. The "right angle turn mechanism" is clearly labeled as item 30 and is made up of turn bars 32 and 33 only. Page 11 lines 19-21, of the specification, states "Collectively, the transport mechanisms may be referred to herein as the "right angle turn transport," and include rollers 23, 24, 36, and turn bars 32 and 33". As written, the right angle turn transport is part of the right angle turn mechanism and this is not true. The right angle turn mechanism cannot use structure that is not associated with it. Turn bars 32 and 33 make up the right angle turn mechanism and, in light of page 11 lines 19-21, turn bars 32 and 33 only make up a portion of the right angle turn transport. Clearly the right angle turn mechanism is a part of the right angle turn transport. Also, there is no support for the right angle turn mechanism being able to perform the function of transporting. The bars 32 and 33 do not have a velocity so they cannot transport the work piece only divert its path.

In regards to claim 3, the phrase "controller coupled to one or more sensors" is unclear. It is uncertain what structure the controller incorporates and what structure allows the controller and the sensors to be coupled.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 2, 4, 5, 6-9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ifkovits et al. (6,443,447) in view of Moser et al. (5,439,208).

In regards to claim 1, Ifkovits et al. disclose the invention including a web feeder providing a web (Fig. 1), the web feeder feeds the web a first direction (102), a web slitting device (14) splitting the web along the first direction into at least two portions (44 and 42), a transverse web cutter cutting the portions of slit web transverse to the first direction while the web is transported through the rotary web cutter to form side-by-side individual sheets (44 and 42), a right angle turn mechanism downstream of the web cutter whereby the individual sheets are rearranged to be one on top of the other in a shingled arrangement (50 and Fig. 3e), the right angle turn mechanism transporting individual sheets with a right angle turn transport having a first velocity (120), and the first velocity capable of being a function of the cutting rate multiplied by the width of the individual sheets (120).

In regards to claim 4, Ifkovits et al. disclose the right angle turn mechanism comprises parallel forty five degree turning bars further comprising a first turning bar forming an inner paper path having a first turning path length (52) and a second turning bar forming an outer paper path having second turning path length (54), and the second turning path length being longer than the first turning path length (Fig. 2).

In regards to claim 5, Ifkovits et al. disclose the first and second turning bars are spaced apart as a function of a sheet length of the sheets such that the shingling arrangement comprises the sheets transported on the inner paper path being positioned at the bottom of the shingling arrangement and sheets transported on the outer paper path being positioned on the top of the shingling arrangement (Fig. 3d).

In regards to claims 6 and 7, Ifkovits et al. disclose the right angle turn transport is capable of controlling to decelerate to a stop and hold sheets upon an occurrence of a downstream stopping condition (Fig. 2) and the web cutter is a rotary cutter (16)

However, with regards to claims 1 and 2, Ifkovits et al. fail to disclose a high speed separation transport downstream of the right angle turn transport and pulling individual shingled sheets out from the shingled arrangement and whereby sheets are thereafter transported serially and separated by predetermined gaps and the high speed separation transport has a velocity that is the function of the cutting rate multiplied by a sum of the length of the individual sheets and the gap.

Moser et al. teaches a high speed separation transport downstream of the right angle turn (22) and pulling individual shingled sheets out from the shingled arrangement and whereby sheets are thereafter transported serially and separated by predetermined gaps and the high speed separation transport has a velocity capable of being the function of the cutting rate multiplied by a sum of the length of the individual sheets and the gap (Column 5 lines 39-50). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Ifkovits et al. with a high speed separation transport, as taught by Moser et al., to separate the sheets for further processing.

The method of claims 8, 9, 11, and 12 can be incorporated into the rejection above.

It is to be noted that claim 3 has not been rejected over prior art. It may or may not be readable over the prior art but cannot be determined at this time in view of the issues under 35 USC § 112.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Irvine et al., Coons, Jr. et al., Auerbach et al. ('240), Auerbach et al. ('772), Lackner et al., Stevens et al., Cote et al., Middleberg et al., Paterson et al., Gunther, and Yates et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:00-4:30, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 18, 2006

A handwritten signature in cursive script, appearing to read "Jason Prone".

Patent Examiner

Jason Prone

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T.C. 3700